

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 17, 24 and 25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,470,338 to Whitfield et al., (hereinafter “Whitfield”). Furthermore, the Examiner rejects claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Whitfield in view of U.S. Patent No. 3,839,772 to Shimomura et al., (hereinafter “Shimomura”). Lastly, the Examiner rejects claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Whitfield and Shimomura further in view of U.S. Patent No. 6,013,095 to Ouchi (hereinafter “Ouchi”).

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claim 17 has been amended to clarify its distinguishing features. Specifically, independent claim 17 has been amended to clarify that the guide is formed in an elongated and tubular shape and that the recovery member is movable in the guide in an axial direction by the elongated circular member. The amendment to claim 17 is fully supported in the original disclosure, such as at Figures 188A-188F of the Drawings and from page 110, line 15 to page 111, line 7 of the Specification. Thus, no new matter has been introduced in the disclosure by way of the amendment to claim 17.

Turning now to the prior art, Whitfield discloses an exclusive tool to close an opening formed by a trocar, and this tool is not used with an endoscope. Further, the level that a needle can penetrate is low, the object to be treated, structure, and how this tool is used is different as compared to the treatment device recited in claim 17. In particular, as the Examiner pointed out in item 8 of the Official Action, in Whitfield, “the recovery member is

held in place in the slots in the housing.” Thus, Whitfield does not disclose or suggest the feature recited in claim 17, i.e., that “the recovery member (e.g., 440) is movable in the guide (e.g., 462) in an axial direction by the elongated circular member (e.g., 681).”

With regard to Shimomura, the same relates to a blade of a machine tool. The object to be treated is clearly different from that of the medical treatment device of the present invention.

With regard to the rejection of claims 17, 24 and 25 under 35 U.S.C. § 102(b), a treatment device having the features discussed above and as recited in independent claim 17, is nowhere disclosed in Whitfield. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”<sup>1</sup> independent claim 17 is not anticipated by Whitfield. Accordingly, independent claim 17 patentably distinguishes over Whitfield and is allowable. Claims 24 and 25 being dependent upon claim 17 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 17, 24 and 25 under 35 U.S.C. § 102(b).

With regard to the rejection of claims 22 and 23 under 35 U.S.C. § 103(a), since independent claim 17 patentably distinguishes over the prior art and is allowable, claims 22 and 23 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 22 and 23 under 35 U.S.C. § 103(a).

Lastly, Figure 182C has been amended to be consistent with the description and the other Figures. Specifically, Figure 182C has been amended to illustrate circular

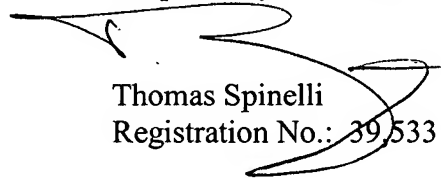
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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

member 681 as being tubular (i.e., the end thereof having an opening) to be consistent with the description and the illustration of the circular member in Figures 183, 184 and 188. Thus, no new matter has been introduced into the disclosure by way of the amendment to Figure 182C. A replacement sheet showing such amendment to 182C is enclosed.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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TS:cm  
Enclosure (Replacement Sheet for Amended Figure 182C)